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PTO/SB/21 (04-07)

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	Filing Date	December 8, 2003	
	First Named Inventor	Shawn W. O'Driscoll	
	Art Unit	3732	
	Examiner Name	C. Stokes	
Total Number of Pages in This Submission	5	Attorney Docket Number	ACM 340US

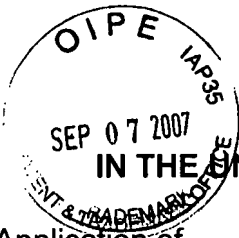
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In re Application of

Date: September 4, 2007

SHAWN W. O'DRISCOLL and DAVID G. JENSEN

Serial No. : 10/731,173

Examiner Candice Capri Stokes

Filed : December 8, 2003

Group Art Unit 3732

For : BONE PLATES

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REPLY BRIEF OF APPELLANTS

This Reply Brief of Appellants is presented in reply to the Examiner's Answer dated July 2, 2007.

At the time of appeal to the Board, claims 3, 9-14, and 31-35 were rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 6,592,578 to Henniges et al. ("Henniges") alone (claims 3, 12-14, and 31-35) or in combination with another reference (claims 9-11). The Examiner's Answer on page 3, line 3, to page 6, line 2, maintained the rejection of these claims on the same grounds and using arguments that appear to be verbatim with those presented in the final Office action dated September 12, 2006. The Appeal Brief of appellants explained the impropriety of the rejections presented in the final Office action and will only be summarized here.

Independent claim 34 recites a set for bone fixation that includes at least three bone plates having different shapes. The bone plates are colored to provide a two-color

system for distinguishing left bone plates from right bone plates. In the two-color system, a pair of the bone plates of different shape are configured to be secured to the same left or right half of a skeleton and include the same color, whereas another of the bone plates of different shape is configured to be secured to the other half of the skeleton and includes a distinct color. The remaining claims depend directly or indirectly from claim 34.

The Examiner cited Henniges for disclosure of a color-coding system for bone plates. However, significantly, the color-coding system of Henniges is different from the two-color system recited by claim 34. The Examiner admitted this difference on the record: "Henniges et al teach the claimed invention except for the distinct color indicating a left or right half of the skeleton" (Examiner's Answer, page 4, lines 13 and 14). The Examiner followed this admission by asserting that it would have been obvious to incorporate a color-coded method for identifying each plate "in order to minimize confusion during a surgical procedure." (*Id.* at lines 15-18). However, the Examiner never provided any support whatsoever for the contention that it would have been obvious to incorporate the two-color system of claim 34. Appellants submit that it would not have been obvious to provide a two-color system for distinguishing left and right bone plates based on the disclosure of Henniges. In particular, Henniges discloses distinguishing each bone plate of different shape and size using a different color.

The Response to Argument section on page 6 of the Examiner's Answer does not address the primary point of contention, namely, the alleged obviousness of claim 34 over Henniges. In the Response to Argument section, the Examiner stated that "Henniges teaches a set of bone plates having different shapes and at least a pair of the

bone plates being capable of being secured to the same left or right half of the skeleton and including the same color.” Appellants strongly disagree. Henniges does not disclose, teach, or suggest a pair of bone plates of different shape for the same half of the skeleton and including the same color. Instead, Henniges discloses distinguishing any pair of distinctly shaped bone plates by color, whether or not the bone plates are configured for the same half or respective left and right halves of a skeleton.

The Examiner concluded the Response to Argument section by stating “[t]herefore, at least a two-color system is provided [by Henniges].” Appellants disagree with the Examiner’s characterization of the color-coding system of Henniges. In particular, appellants contend that Henniges provides an N-color system for distinguishing different bone plates, where N is the number of different bone plates. Accordingly, with at least three bone plates of different shape (as recited by claim 34), Henniges would provide at least a three-color system for distinguishing the bone plates, whatever the left/right sidedness of each bone plate, instead of the two-color system for distinguishing left and right bone plates recited by claim 34. In other words, the system of Henniges would differ in at least two significant ways from the system of claim 34: (1) it would have too many colors, and (2) it would not correlate those colors with left/right sidedness. Furthermore, the Examiner provided no teaching, suggestion, or motivation to make any modification to the color-coding system of Henniges, and particularly not to provide the set of at least three bone plates recited by claim 34. Therefore, the Examiner has not established a *prima facie* case of obviousness for any of the pending claims.

The rejections of claims 3, 9-14, and 31-35 under 35 U.S.C. § 103(a) are improper for at least the reasons set forth above and in appellants' earlier-filed Appeal Brief. Accordingly, appellants maintain their position that all of the rejections of the pending claims should be reversed.


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Respectfully submitted,

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